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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,684	12/08/2003	Edward J. Vasel	81079 7304	3287
22342 7590 08/06/2008 FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406				
EXAMINER				
CLEMENT, MICHELLE RENEE				
ART UNIT		PAPER NUMBER		
3641				
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08/06/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/731,684

**Applicant(s)**

VASEL ET AL.

**Examiner**

Michelle (Shelley) Clement

**Art Unit**

3641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-15, 17-25 and 53-71 is/are pending in the application.
- 4a) Of the above claim(s) 69 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 71 is/are allowed.
- 6) ☒ Claim(s) 13-15, 17-25, 53, 55, 59 and 65-70 is/are rejected.
- 7) ☒ Claim(s) 56-58 and 60-64 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 10/12/07 have been fully considered but they are not persuasive. In response to applicant's contention that Oberfell does not teach "a propulsion block that maintains substantially all of a propulsion force behind the propulsion block, or a propulsion block that evenly distributes the propulsion force to the projectile" it is note that the claims merely require the propulsion block *configured* to achieve the claimed result but do not require any specific structure to achieve the claimed result. Applicant is attempting to argue that not all propulsion blocks achieve the claimed result and the propulsion block requires a *specific* structure in order to achieve the claimed result. Applicant's arguments are narrower than the breadth of the current claims, furthermore the scope of the claims is not enabled for such a narrow interpretation. Oberfell teaches the claimed propulsion block, the propulsion block has the ability to maintain substantially all of a propulsion force behind the propulsion block and to evenly distribute the propulsion force to the projectile and therefore has structure (i.e. the block fills the entire inner surface of the shell and the purpose of the block/wad is to effectively seal the high pressure, rapidly expanding gasses, thereby sealing the bore and minimizing the blow-by of gases (column 1, lines 20-35) or is configured to achieve the stated result. If the block did not evenly distribute the propulsion force, it would have the ability to minimize blow-by as the block will skew in the bore (as a result of unevenly distributed forces) and allow the expanding gases to seep out (i.e. blow-by) prior to the block exiting the bore.

***Specification***

2. The amendment filed 10/12/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the means for launching rapidly launches a sub-set of multiple projectiles of the plurality of projectiles within the limited time **of about less than two seconds**.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

3. Claim 66 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The means for launching rapidly launches a sub-set of multiple projectiles of the plurality of projectiles within the limited time **of about less than two seconds** was not described in the specification at the time the application was filed.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, 18-19, 21, 23, 24, 59, 65, 67, 68 rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. (US Patent # 3,650,213) in view of Oberfell et al. (US Patent # 3,053,185). Abbott et al. discloses a projectile system for use in delivering a substance to a target comprising a projectile comprising a first part, a second part that is at least partially hollow, wherein the second part is secured with the first part to seal the hollow portion defining a volume, the projectile is non-spherical, an inhibiting substance contained within the volume and stabilizing fins secured with the second part along an exterior of the second part and a block (reference 41), made of foamed polyethylene, positioned proximate to the stabilizing fins wherein the inhibiting substance is dispersed into a cloud upon impact of the projectile with a target. The first part is at least partially hollow where the hollow portion of the first part cooperates with the hollow portion of the second part defining a volume such that the inhibiting substance is contained within the volume. The second part tapers to a smaller diameter away from the first part and the second part has a length that is greater than a width of the first part. Comprising a shell/cartridge coupled with the second part, an ignitable substance (i.e. means for launching the projectile) positioned within the shell/cartridge, wherein the ignitable substance propels the projectile from the shell upon ignition of the ignitable substance (Figure 4). The block is positioned within the shell adjacent the propulsion block and the ignitable substance includes primer positioned within the shell such that the primer when ignited propels the propulsion block which forces the projectile from the shell. Abbott et al. discloses the projectiles can be launched from shells/cartridges, it is inherent that any number/plurality of projectiles of Abbott et al. can be provided and any number/plurality of cases (means for launching the plurality of projectiles) can also be provided. The plurality of projectiles can also be launched in a set or

in sub-sets within a limited time (note 24 hours could constitute a limited time) and they are intended to contact a target along a path across the target. A plurality of shells can be provided, each shell housing at least one projectile, wherein the means for launching comprises ignitable substance positioned within each shell, the ignitable substance propels the projectile from the shell, the ignitable substance comprises one or more primers that will launch each of the projectiles at consistent projectile velocities. Although Abbott et al. does not expressly disclose the purpose of the block to maintain *substantially* all of a propulsion force behind the block and to evenly distribute the propulsion force to the projectile, Oberfell et al. does. Oberfell et al. teaches an expandable wad for shotgun shells made of foamed polyethylene that expands in order to utilize the driving force of the gas from the burning gun powder. The block comprising a lip (reference 19, 39) extending radially and circumferentially about an exterior of the block where the lip is flexible. Both Oberfell et al. and Abbott et al. teach the projectiles in shells/cartridges, the projectiles can be launched from the shells by a firearm device which has the ability to launch a plurality of the projectiles and a single projectile. Oberfell et al. and Abbott et al. are analogous art because they are from the same field of endeavor: shot cartridges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the expandable propulsion block as suggested by Oberfell et al. with the projectile system as disclosed by Abbott et al. The suggestion/motivation for doing so would have been to obtain a projectile system in which all the propulsive forces of the propulsion gases were utilized for propelling the projectile. The [a)statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other

statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

5. Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Abbott et al.* and *Oberfell et al.* as applied to claims 13, 18, 19, 23 and 24 above, and further in view of *Fedida* (US Patent # 5,821,450). Although *Abbott et al.* does expressly disclose the inhibiting substance including capsaicin, *Fedida* does. *Fedida* teaches an improved inhibiting substance for use in incapacitating systems. *Abbott et al.*, and *Fedida* are analogous art because they are from the same field of endeavor: incapacitating systems. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the inhibiting composition including capsaicin as suggested by *Fedida* with the system as disclosed by *Abbott et al.* and modified by *Oberfell et al.* The suggestion/motivation for doing so would have been to obtain an incapacitating system with the improved properties as suggested by *Fedida*.

6. Claims 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. and Oberfell et al. as applied to claims 13-15 and 18-20 above, and further in view of Barr (US Patent # 3,865,038). Although Abbott et al does not expressly disclose the projectile system wherein the first part is reusable and *generally* non-frangible with support structures, Barr does. Barr teaches an inhibiting projectile comprising a *generally* non-frangible nose section that can be reused and comprising support structures. Abbott et al. and Barr are analogous art because they are from the same field of endeavor: inhibiting projectiles. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the nose structure as suggested by Barr with the projectile system as disclosed by Abbott et al. and modified by Oberfell et al. The suggestion/motivation for doing so would have been to obtain a projectile system with less waste.

7. Claims 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. and Oberfell et al. as applied to claims 13-15 above, and further in view of Rousseau (US Patent # 4,589,342). Although neither Abbot et al. nor Oberfell et al. expressly disclose the projectile system further comprising additional stabilizers distinct from the stabilizing fins, Rousseau does. Rousseau teaches a projectile comprising stabilizing fins and additional stabilizers distinct from the stabilizing fins wherein the additional stabilizers are positioned on the exterior of the same part as the stabilizing fins but distant from the stabilizing fins. The additional stabilizers are positioned on the exterior and extend along a length of the part. All of the component parts are known in the references. The only difference is the combination of the "old elements" into a single device. Thus, it would have been obvious to one having ordinary skill in the art to mount the additional stabilizers taught by Rousseau onto the projectile as shown



in Abbott et al. and modified by Oberfell et al., since the operation of additional stabilizers are in no way dependent on the operation of the other equipment of a projectile, and additional stabilizers could be used in combination with a standard projectile to achieve the predictable results of greater projectile control.

8. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. and Oberfell et al. as applied to claim 13 above, and further in view of Prentice et al. (US Patent # Des. 348,907). Although neither Abbott et al. nor Oberfell et al. expressly disclose the second part comprising a body portion removably secured with a tail portion, Prentice et al. suggests a removable fin part/tail portion for a projectile. All of the component parts are known in the references. The only difference is the combination of the "old elements" into a single device. Thus, it would have been obvious to one having ordinary skill in the art to mount the removable fin portion onto the projectile as shown in Abbott et al. and modified by Oberfell et al., since the operation of the removable portion is in no way dependent on the operation of the other equipment of a projectile, and the removable portion could be used in combination with a standard projectile to achieve the predictable results easier manufacturing.

9. Claim 70 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abbott et al. in view of Oberfell et al. and Rousseau. (See ¶ above with regards to claim 53).

***Allowable Subject Matter***

10. Claims 56-58, 60-64 are objected to as being dependent upon a rejected base claim, but would possibly be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 71 is allowed.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/  
Primary Examiner, Art Unit 3641